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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,602	03/22/2004	Pietro Rancan		2448

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12 East 41st Street
New York, NY 10017

EXAMINER

COZART, JERMIE E

ART UNIT	PAPER NUMBER
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3726

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/806,602

Applicant(s)

RANCAN, PIETRO

Examiner

Jermie Cozart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/536,672, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The specification of 09/536,672 fails to provide support for the steps of joining, rolling, drawing, and cutting in **claim 7** of the present application (10/806,602). The specification of 09/536,672 fails to provide support for the limitations of **claims 8-16 and 21-30** of the present application (10/806,602).

2. The benefit claim filed on 9/9/05 was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of

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the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires the benefit under 35 U.S.C. 120 based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Claim Objections

3. Claim 13 is objected to because of the following informalities: In **claim 13**, *line 1*, the claim depends from non-elected claim 5 which is also directed to a different invention, therefore it is recommended in **claim 13**, *line 1*, "5" should be changed to

- -7- -. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 21-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Lacchetti et al. (USPGPUB 2002/0029476) and Lacchetti et al. (US 6,601,301).

Applicant seeks to provoke an Interference with U.S. Pat. 6,601,301 to Lacchetti et al. See Applicant's Remarks dated August 5, 2004. U.S. Pat. 6,601,301 issued based on the application filed, which published as U.S. Pat. App. Pub. No. 2002/0029476.

Thus, Applicant admits the Lacchetti reference discloses the same claimed invention as Applicant.

Regarding **claims 21-25**, Applicant purposely copied these claims verbatim from claims 1-5 of Lacchetti. See Applicant's Remarks dated August 5, 2004.

Regarding **claims 26-30**, Applicant merely changed the terms from the language in claims 1-5 of Lacchetti.:

"two-sided" to - -omega-double-face- - (see Claim 26, line 1);

"pipe section" to - -ring- - (see Claim 26, line 2);

"pipe" to - -tubular element- - (see Claim 26, line 3); and

"band" to - laminae- - (see Claim 26, line 5).

These terms are merely synonyms in the context of the invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacchetti et al. (USPGPUB 2002/0029476) in view of Knight (450,412) and Gusky (5,611,144).

Lacchetti discloses the a method for making a reversible Omega chain comprising the steps of:

providing a first strip (3) of a first material;

providing a second strip (4) of a second material;

joining the first strip and the second strip together at one lengthwise side (see Figure 1);

rolling the joined strips to form a hollow tube (19);

cutting the tube radially at specific increments to provide a plurality of rings (see [0030]); and

inserting the rings onto a core to form the omega chain (see [0031]).

With respect to the then prior art and forming hollow necklaces and chain, Lacchetti discloses, a "chain is formed by a succession of links which are essentially

cylindrical and in general flattened and show an elliptic section. These links are put near each other on a flexible core" and mounted. See [0005]. The Examiner interprets "elliptic" to be a synonym of "oval," as used by Applicant in the context of the invention.

Lacchetti, however, does not specifically disclose drawing the tube over a substantially oval shaping element to form a substantially oval tube to form the elliptic section, and pressing the rings on the core to provide the omega chain.

Knight discloses a method for making tubular jewelry stock having the same general configuration and formed by the same steps, e.g., joining two bands together, bending them and welding the seam to form a tube, as the tube of Lacchetti. *See Figures 1 and 3.* The reference further discloses, the "tube is now drawn through a draw-plate, the area of which is less than the area of the sectional outline of the tube, so as to consolidate and lengthen the tube, and the tube is successively drawn through draw-plates or elongated and reduced in thickness by rolling until a tube, rod, or wire of the desired size and cross-sectional is produced." *Page 2, Col. 1, lines 2-9.* One having ordinary skill in the art at the time of invention recognizes that for a hollow tube, a mandrel is required in a drawing operation such that the tube does not collapse. *See generally, Choate, Sharr, "Creative Gold- and Silversmith," pages 119-121 (disclosing use of draw-plate in conjunction with a mandrel for forming tubing); See Butty (5,809,822) discloses forming tube, e.g., jewelry, see column 1, lines 19, by using a draw-plate in conjunction with a mandrel; See Higgins (1,422,974), column 1, lines 41-48 disclosing use of draw-plate in conjunction with a mandrel.*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the omega chain of Lacchetti by drawing the tube over a substantially oval shaping element to form a substantially oval

tube, in light of the teachings of Knight, in order to form the desired thickness and cross-section of the tube.

However, neither Lacchetti nor Knight discloses pressing the rings on the core to provide the omega chain.

Gusky discloses an Omega chain of the type claimed by Lacchetti. The reference discloses that in the then prior art it was known to place the links on the flexible core and pressed them in place thereby to engage the links on the core and to provide the final cross sectional shape of the chain. *See Col. 1, lines 14-31.* Gusky improves upon the prior art by providing an embossed decorative pattern on the surface formed by the pressing step. *See Abstract.*

Regarding **claim 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the Omega chain of Lacchetti/Knight by performing a final pressing operation to press the rings of the core, in light of the teachings of Gusky, in order to engage the links onto the core, provide the final cross-sectional shape of the claim, and/or to provide an embossed decorative pattern on the surface.

Regarding **claims 8 and 11-16**, these features are disclosed in the prior art cited. *See generally, Lacchetti and Gusky.* Regarding the design features, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have changed the design of the jewelry article to make it more aesthetically pleasing. *See In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (aesthetic design changes

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relating to ornamentation only which have no mechanical function held to be prima facie obvious over prior art).

Regarding claims 9 and 10, the cordon of Applicant appears to be essentially a welding seam that is later removed by the drawing process. *See the specification particularly paragraph [0031]*. Applicant has not suggested a benefit of this feature. Lacchetti/Knight rely on a weld seam, which would similarly be removed during the drawing step by the mandrel. The mandrel is "calibrated" in the sense that it provides a desired internal diameter to the tube. *See the specification particularly paragraph [0032]*.

Interference

8. The request for interference filed April 27, 2006 is acknowledged. However, as outlined hereinabove, examination of this application has not been completed as required by 37 CFR 41.102(a). Consideration of a potential interference is premature. See MPEP § 2303. However, as Applicant has suggested an interference pursuant to 37 CFR 41.202(a) in the communication filed April 27, 2006, the following observations with respect to the request are noted. Correction of the issues outlined below will be necessary prior once examination is concluded.

9. Applicant failed to (1) identify all claims the applicant believes interfere, and/or (2) propose one or more counts, and/or (3) show how the claims correspond to one or more counts. See 37 CFR 41.202(a)(2) and MPEP § 2304.02(b). Specifically, the request is deficient with respect to (1) in that it does not discuss all claims pending in the instant application. Also, the request is deficient with respect to (3) showing how the claims correspond to the count. Claims do not correspond because they are dependent upon

a claim equivalent to the count or because they are copied from a patent. The meaning of correspondence may be found in 27 CFR 41.207 (b)(2). In short, claim correspondence is based upon the subject matter of the count, the subject matter of the claim and the state of the prior art. Admissions that the claim would be rendered anticipated by or obvious in view of the count, should it be considered prior art, are acceptable.

10. Applicant failed to provide a claim chart comparing at least one claim of each party corresponding to the count. See 37 CFR 41.202(a)(3) and MPEP § 2304.02(c). This should be a side by side listing of the count, at least one claim of each party and an explanation of why the claims interfere. This explanation could be as simple as "the claims are identical to the count and thus are anticipated by the count" or quite detailed including a means-plus function analysis with reference to the specification and the patent, should such be the situation. Applicant is reminded the rules have been drafted to encompass all potential interference situations including those much more complicated that applicants.

11. Applicant failed to provide a detailed explanation as to why applicant will prevail on priority. See 37 CFR 41.202(a)(4), (a)(6), (d) and MPEP § 2304.02(c). As outlined above, presently applicant is seen as the junior party. Applicant may pursue a petition to establish an additional claim for priority as outlined hereinabove and include an explanation of how this prior application fully enables the count (provision of chart required by 37 CFR 41.202(a)(6). Alternatively, applicant may present an evidentiary showing which rises to the level to overcome the 35 USC 102(e) rejection but submitting

his evidence of conception and diligence under this section of the request for interference rather than under 35 USC 1.131. See MPEP 2304.02(c), particularly section I.

12. Claim at least claims 20-25 and 26-30 have been added or amended in a communication filed on August 5, 2004 to provoke an interference. Applicant failed to provide a claim chart showing the written description for each claim in the applicant's specification. See 37 CFR 41.202(a)(5) and (a) (6) and MPEP § 2304.02(d). The chart provided is incomplete: It does not include claims 20-25.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JERMIE E. COZART
PRIMARY EXAMINER

April 11, 2007